

### **Remarks**

Claims 37 to 42 are pending. Claim 37 is allowed. Claims 38, 39, and 41 are hereby amended. Claims 40 and 43 are hereby canceled.

For clarification purposes only, Applicants have amended Claim 38 by replacing the phrase “less than” with the phrase “not extending beyond.” The amendment does not narrow the scope of the claim and is supported by Figs. 1c, 3c, and 5d, and text in the specification describing these figures. For clarification purposes only, Applicants have also amended Claim 38 by replacing the term “remains” with “is.”

### **Rejections**

#### **102 Rejection**

Claims 38 to 42 stand rejected under 35 USC § 102 as being anticipated by Abolafia et al. (U.S. Patent 3,795,047).

The Office Action states in part:

As to Claim 38, Abolafia et al. discloses, in Figs. 2, 3 and 4, an electronic circuit element 10c comprising: a first insulating layer 11 (col.3: 31-32) having at least one surface (i.e., the upper surface), at least a portion of the surface defining a first surface plane; at least one conductor 13 along at least a portion of the at least one surface; a conducting member 18 in communication with the at least one conductor 13, the conducting member (spherical particle 18) protruding to an apex at a first level, the first level beyond the first surface plane (Fig. 4), the conducting member 18 including a surface (i.e., the surface of the sphere); the surface of the insulating layer 11, the at least one conductor 13, and the surface of the conducting member 18, defining a major surface of a predetermined shape; a second insulating layer 17 along at least a portion of the major surface (col.4: 22-23 and 32-38) whereby at least a portion of the conducting member 18 remains exposed (Fig. 4); the second insulating layer 17 including portions extending laterally from the conducting member 18 along the first insulating layer 11 (Figs. 2 and 4; col.4: 32-38); the laterally extending portion extending from the first surface plane to a second level, the second level less than the first level (Fig. 4) wherein the second insulating layer 17 includes an adhesive, i.e., an epoxy, which is a thermosetting adhesive (col.4: 22-23 and 32-44).

As to Claim 39, Abolafia et al. further discloses that the exposed portion of conducting member 18 is proximate the apex (Fig. 4).

As to Claim 41, Abolafia et al. further discloses that at least a portion of the second insulating layer 17 conforms to the predetermined shape of the major surface (Figs. 2 and 4).

As to Claim 42, Abolafia et al. further discloses that the laterally extending portions of the second insulating layer 17 extend from the first surface plane to a second plane at the second level (Figs. 2 and 4).

Applicants submit that “A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.”

MPEP 2131 (citing *Verdegall Bros. V. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987)).

Applicants have amended the claims to limit the “conducting member(s)” to solder ball(s). The amendment is supported by the specification at, e.g., page 17, line 1. The “conducting members” of Abolafia are metal powder particulate, which are usually harder than the conductive circuit surfaces. See Abolafia at, e.g., col. 1, lines 68-col. 2, line 1 and col. 2, lines 15-18). Abolafia does not disclose conducting members made of solder material. Accordingly, the reference does not describe every element of the claimed invention.

Based on the foregoing, Applicant(s) submit that the cited reference cannot support a 35 U.S.C. 102 (b) rejection and respectfully requests that the rejection be withdrawn.

In addition to the foregoing arguments, Applicant(s) submit that a dependent claim should be considered allowable when its parent claim is allowed. *In re McCairn*, 1012 USPQ 411 (CCPA 1954). Accordingly, provided the independent claims are allowed, all claims depending therefrom should also be allowed.

Based on the foregoing, it is submitted that the application is in condition for allowance. Examination and reconsideration of the claims are requested. Allowance of the claims at an early date is solicited.

The Examiner is invited to contact Applicant(s)’ attorney if the Examiner believes any remaining questions or issues could be resolved.

Respectfully submitted,

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Date

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